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| 09/787,961      | 03/22/2001  | Stefan Prange        | 112740-194          | 1231             |

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EXAMINER

WINTER, JOHN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3621

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/787,961

Applicant(s)

PRANGE ET AL.

Examiner

John M Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 22-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 22-30, 33-37, 39 and 40 is/are rejected.
- 7) ☒ Claim(s) 31, 32, 38 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

Claims 22-42 remain pending.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### *Response to Arguments*

The Applicants arguments filed on December 30, 2004 have been fully considered but are not persuasive.

The Applicant submits that the Kawan ('532) reference does not disclose the feature of "asking a user, at the mobile radio device, for confirmation for the payment"

The Examiner responds Kawan discloses "an embodiment of the invention in which a wireless server/terminal unit is used to exchange financial information between a user and a remote host computer of a financial institution", i.e. a user and a mobile radio device; at Column 8, lines 28-30 Kawan discloses that "the user accepts the transaction and purchase amount entered by the merchant by entering the users PIN". The Examiner concludes user confirms the transaction by entering the pin code, thusly all of the claimed limitations are met .

The Applicant submits that the Terranova ('879) reference does not disclose the feature of the claimed method which includes communication between a base station communication station, a mobile radio device and a telecommunications device.

The Examiner responds that Terranova discloses the features of "via the mobile radio device, by transmitting payment instruction data upon the confirmation for the payment; and transmitting acknowledgement data for the payment operation to the base telecommunication station via at least one of the mobile radio device and a telecommunication device of one of a financial institution and a bill issuer" as per figure 23. The central control system of figure 23 is connected to a network ledger (i.e. a base telecommunication station and a financial institution.)

The Applicant submits that the Rosen ('423) reference does not disclose the feature of using a mobile radio to transmit financial data.

The Examiner responds that the feature rejected by Rosen "transmitting payment instruction data upon confirmation of the payment to a telecommunications device of one of a financial institution and a bill issuer" does not specifically state that a mobile radio device is utilized, the term "transmission" is generally construed as means for moving information from one location to another.

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The Applicant states that the claims of the present invention are directed towards a different purpose and are not obvious in view of the prior art.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of conducting secure electronic commerce and therefore the combination of said references would be obvious to a person of ordinary skill in the art.

See following rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-30,33-37,39,40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (US Patent No 6,442,532) in view of Terranova (US Patent 6,098,879) and further view of Rosen. (US Patent 5,953,423)

As per claim 22,

Kawan ('532) discloses a method for paying for goods and services using both a mobile radio device and a base telecommunication station which communicates with the mobile radio device via electromagnetic waves, the method comprising the steps of:

transmitting data required for payment from the base telecommunication station to the mobile radio device;(Column 5, lines 13-21)

asking a user, at the mobile radio device, for confirmation for the payment;(Column 8, lines 28-30, column 6, lines 7-15)

Kawan ('532) does not explicitly disclose initiating a payment operation, via the mobile radio device, by transmitting payment instruction data upon the confirmation for the payment; and transmitting acknowledgement data for the payment operation to the base telecommunication station via at least one of the mobile radio device and a telecommunication device of one of a financial institution and a bill issuer. Terranova ('879) discloses initiating a payment operation, via the mobile radio device, by transmitting payment instruction data upon the confirmation for the payment; and transmitting acknowledgement data for the payment operation to the base telecommunication station via at least one of the mobile radio device and a telecommunication device of one of a financial institution and a bill issuer. (Column 31, lines 23-29). It would be obvious to one having ordinary skill in the art at the time the invention was

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made to combine the Kawan ('532) method with the Terranova ('879) method in order to prevent fraudulent transactions from occurring.

Kawan ('532) does not explicitly disclose transmitting payment instruction data upon confirmation of the payment to a telecommunications device of one of a financial institution and a bill issuer. Rosen. ('423) discloses transmitting payment instruction data upon confirmation of the payment to a telecommunications device of one of a financial institution and a bill issuer(Figure 15A). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Rosen. ('423) method in order to allow the transaction to be processed by an online banking system.

As per claim 23,

22, Kawan ('532) discloses a method for paying for goods and services as claimed in claim

wherein the step of initiating a payment of operation includes the mobile radio device communicating directly with a telecommunication device of a financial institution.(Column 4, lines 53-60).

As per claim 24

22, Kawan ('532) discloses a method for paying for goods and services as claimed in claim

herein the step of initiating a payment operation includes the mobile radio device transmitting the payment instruction data to the base telecommunication station, and the base telecommunication station transmitting the payment instruction data to a telecommunication device of a financial institution via a landline network connection.(Column 3, lines 13-26)

As per claim 25

22, Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22, the method further comprising the step of:

converting, via the mobile radio device, the data received from the base telecommunication station into a format which is suitable for a payment operation before transmission.(Column 3, lines 34-37)

As per claim 26

22, Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22, the method further comprising the step of:

authenticating the user of the mobile radio device before the step of initiating the payment operation.(Column 8, lines 61-66)

As per claim 27

26, Kawan ('532) discloses a method for paying for goods and services as claimed in claim

wherein the user is authenticated via at least one of a personal identification number entry and biometric features.(Column 8, lines 61-66; column 9, lines 1-3)

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As per claim 28

22, Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22, wherein an electronic cash register transmits the data required for payment to the base telecommunication station.

As per claim 29

22, Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22.

Kawan ('532) does not explicitly disclose transmitting, via the base telecommunication station, a key generated in one of the base telecommunication station and an associated unit to the mobile radio device; transmitting the key, via the mobile radio device, to the telecommunication device of one of a financial institution and a bill issuer. Terranova ('879) discloses transmitting, via the base telecommunication station, a key generated in one of the base telecommunication station and an associated unit to the mobile radio device; transmitting the key, via the mobile radio device, to the telecommunication device of one of a financial institution and a bill issuer.(Column 31, lines 55-67; column 32, lines 1-9). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to protect the users identity by authenticating the user.

Official Notice is taken that "transmitting the key to the base telecommunication station by the telecommunication device of one of the financial institution and the bill issuer" is common and well known in prior art in reference to wireless transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmitting the key to the base telecommunication station by the telecommunication device of one of the financial institution and the bill issuer because this allows authentication of the user.

As per claim 30

Kawan ('532) discloses a method for paying for goods and services as claimed in Kawan ('532) does not explicitly disclose the key is used at least on particular transmission paths to encrypt data which is to be transmitted. Terranova ('879) discloses the key is used at least on particular transmission paths to encrypt data which is to be transmitted(Column 30, lines 39-44). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to protect the users identity.

As per claim 33

22, Kawan ('532) discloses a method for paying for goods and services as claimed in claim 22,

Kawan ('532) does not explicitly disclose the mobile radio device and the telecommunication device of one of a financial institution and a bill issuer communicate on the basis of a mobile radio standard. Terranova ('879) discloses the mobile radio device and the telecommunication device of one of a financial institution and a bill issuer communicate on the

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basis of a mobile radio standard.(Column 31, lines 9-25). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to promote interoperability of commercial systems.

As per claim 34

29. Kawan ('532) discloses a method for paying for goods and services as claimed in claim

Kawan ('532) does not explicitly disclose comparing the transmitted key with a key stored in one of the base telecommunication station and an associated unit; and providing at least one of goods and services upon a successful comparison between the transmitted key and the key stored. Terranova ('879) discloses comparing the transmitted key with a key stored in one of the base telecommunication station and an associated unit; and providing at least one of goods and services upon a successful comparison between the transmitted key and the key stored. (Column 31, lines 9-25). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to prevent fraudulent transactions from occurring.

As per claim 35

29. Kawan ('532) discloses a method for paying for goods and services as claimed in claim

Official Notice is taken that "the key is transmitted together with at least one of data required for the payment operation and acknowledgement data for the payment operation." is common and well known in prior art in reference to wireless transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmitting the key to the base telecommunication station by the telecommunication device of one of the financial institution and the bill issuer because this allows authentication of the user.

As per claim 36

22. Kawan ('532) discloses a method for paying for goods and services as claimed in claim

wherein the data required for payment includes at least one of a sum of money which is to be paid, a name for the goods to be paid for, a name for the service to be paid for, a recipients account number, a bank sort code, a purpose of use, a customer (Column 6, lines 39-57).

As per claim 37

Kawan ('532) discloses a system for securely paying for goods and services, comprising: a base telecommunication station having a radio device for transmitting data required for payment to a mobile radio device and for receiving data from the mobile radio device;the mobile radio device which includes a reception device for receiving the data transmitted by the base telecommunication station,(Column 5, lines 13-21)

an interrogation device connected to the reception device for requesting confirmation for the payment,(Column 8, lines 28-30)

Kawan ('532) does not explicitly disclose transmission device connected to the interrogation device for transmitting data for at least one of initiating a payment operation and

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transmitting acknowledgement data for the payment operation to the base telecommunication station. Terranova ('879) discloses transmission device connected to the interrogation device for transmitting data for at least one of initiating a payment operation and transmitting acknowledgement data for the payment operation to the base telecommunication station. (Column 31, lines 23-29). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to prevent fraudulent transactions from occurring.

As per claim 39

Kawan ('532) discloses a system for securely paying for goods and services as claimed in claim 37, the system further comprising:

an electronic cash register connected to the base telecommunication station, the electronic cash register designed to transmit the data required for payment to the base telecommunication station.(Figure 2A).

As per claim 40

Kawan ('532) discloses a system for securely paying for goods and services as claimed in claim 37,

Kawan ('532) does not explicitly disclose a computing device, associated with the base telecommunication station, for at least one of producing and verifying a key. Terranova ('879) discloses a computing device, associated with the base telecommunication station, for at least one of producing and verifying a key. (Column 31, lines 55-67; column 32, lines 1-9). It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Kawan ('532) method with the Terranova ('879) method in order to protect the users identity by authenticating the user.

As per claim 42

Kawan ('532) discloses a system for securely paying for goods and services as claimed in claim 37,

wherein the data required for payment includes at least one of a sum of money which is to be paid, a name for the goods which are to be paid for, a name for the services which are to be paid for, a recipients account number, a bank sort code, a purpose of use, a customer number, and a telephone number of a telecommunication device of one of a financial institution and a bill issuer.(Column 6, lines 39-57)

### ***Allowable Subject Matter***

Claims 31,32,38 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complying with double patenting statutes.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."



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*Conclusion*

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

April 4, 2005

JMW



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